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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re: application of)
Gunther Oskar ECKERT) AU 2854
Application No. : 10/585,449) Ex.: Yuan L. Chen
Filed : July 7, 2006)
For : PRINTING MACHINE COMPRISING)
A FORMER)

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Restriction Requirement, which was mailed to the undersigned in the subject U.S. patent application on August 11, 2008, applicant elects to prosecute, in this application, the invention or group of inventions identified by the Examiner as Group I, claims 22 and 23. Applicant expressly reserves the right to file one or more divisional patent applications directed to the inventions or groups of inventions not selected for prosecution in this application.

In the Restriction Requirement, the Examiner asserts that the listed Groups I-XVII do not relate to a single inventive concept under PCT Rule 13.1 because of a determination made in the Written Decision of the International Search Office, dated April 7, 2005. It was asserted in that Written Decision that the D1 and D2 reference, when combined, showed that claims 1-21 lacked inventive activity.

The Examiner has failed to notice that claims 1-21, which were acted on in the International Search Report, of which the Written Decision was a part, were amended by the Article 34 Amendment filed on April 28, 2005. Those amended claims, also 1-21, were noted in the IPER of February 15, 2006 as having both novelty and inventive activity. Claims 22-45, the claims pending in the subject application and the ones subject to the Restriction Requirement, are essentially the same in scope as claims 1-21 which were the subject of the IPER. In this regard, note the assertion in the Preliminary Amendment.

The Examiner's holding of lack of a single inventive concept under PCT Rule 13.1 is incorrect. It is based on a rejection of claims that do not correspond to the claims now pending in the application.

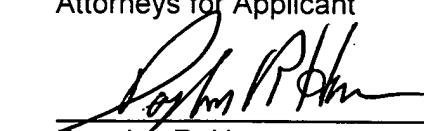
The Examiner also asserts that this restriction is proper because there would be a serious search or examination burden because of one or more of the reasons listed at pages 6 and 7 of the Detailed Action. The Examiner has provided no support for his conclusion. Claims 22-45, all of the claims now pending in the application, are directed to a printing press adapted to print a web of material. Claim 22 is the sole independent claim. It is difficult for the undersigned to understand how the Examiner will be subjected to a "...serious search and examination burden..." by the consideration of one independent claim and its 24 dependent claims. There is no evidence provided of different fields of classification or of divergent subject matter. There is no evidence that these claims will require different fields of search. There is no evidence that prior art applicable to one invention would not be applicable to another invention. There is certainly no evidence, or indication in the record of any 35 U.S.C. 101 or 35 U.S.C. 112, first paragraph issues.

It is believed that all of the claims present in the subject application constitute one invention or group of inventions. The Restriction Requirement is believed to be improper and its withdrawal is requested. An early and favorable Office Action on the merits is respectfully requested.

Respectfully submitted,

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